

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Thomas M. Laney et al.

Group Art Unit: 1791
Examiner: Patrick Neal butler

METHOD OF MAKING
POLYLACTIC-ACID-BASED SHEET
MATERIAL

Serial No. 10/722,887

Filed November 26, 2003

Mail Stop APPEAL BRIEF - PATENTS
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANTS' REPLY BRIEF

This Reply Brief is necessitated by several "new points of argument" in the Examiner's Answer mailed May 28, 2008. Each new point of argument is addressed below in turn.

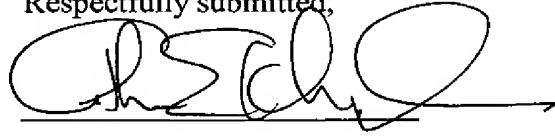
1) At page 7, line 11 - page 8, line 3 of the Examiners Answer the Examiner newly raises the question of Morita actually forming a product with absorbency by stating that Morita discloses absorbency at column 1, lines 18-27, where forming of a permeable product able to absorb moisture is set forth. The Examiner stated this in response to the Appellants urging that the Examiner required Morita to form a product outside the invention of Morita in order to meet the claims 19 and 40 limitations. The Examiner also points out the column 1, lines 18-27 portion of Morita, as forming a material able to absorb moisture and still be within the invention of Morita. This argument is respectfully traversed. The portion at column 1, lines 18-27 cited by the Examiner states that the film has permeability, but this is not a teaching of absorbency. In fact, it is a teaching of water vapor permeability not

absorbency. This is shown by the continuation of the same sentence where it is stated that the films are "leak-proof films", such as used in diapers and sanitary materials. This clearly is not an absorbent film as it would not be suitable for use as a "leak-proof" film if it was absorbent. Therefore, there is no teaching or suggestion in Morita to form an absorbent film, and the entire purpose of Morita is directed to a moisture permeable leak-proof film. Therefore, one performing the Morita process would not produce the film of the invention as only water vapor permeable leak-proof films are formed in Morita. Therefore it is urged that the rejection over Miranda be reversed.

2) The Examiner at page 10, line 11- page 12, line 2 newly argues in response to the Appellants argument that there is no teaching or suggestion for the combination of references. The Examiner states that while any judgment on obviousness is necessarily reconstruction based upon hindsight reasoning, nevertheless, so long as it takes into account only knowledge that is in the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned from the applicants disclosure such reconstruction is proper. This argument is respectfully traversed. The Examiner is modifying a teaching to make transparent films (Matsumoto), and a teaching making a water vapor permeable surface on an imaging support (Laney) to produce the absorbent sheet of the invention. There is no teaching of forming a stand alone absorbent sheet in either of these references although the ink absorbing layer of Laney would be absorbent. Matsumoto is directed to a transparent sheet and has no suggestion the sheet be modified to be absorbent which would be entirely outside the intended purpose of Matsumoto. Laney teaches away from the invention in requiring a base sheet to be under the absorbent sheet. Further, as Laney is making a sheet for inkjet printing it would not be desirable for the whole sheet be absorbent. The Examiner states that there is motivation for the combination but has not pointed out any suggestion for modification in either reference to achieve the instantly claimed invention. Therefore, it is urged that the rejection over Matsumoto in view of Laney be reversed.

For these reasons, as well as those presented in Appellants' Brief, Appellants respectfully submit that the Final Rejection is in error, and they request its reversal by the Honorable Board.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'AKL', is written over a horizontal line. The signature is stylized with large, looping letters.

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